

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jerding, *et al.*

Confirmation No.: 1598

Group Art Unit: 2623

Serial No.: 09/590,904

Examiner: Shang, Annan Q.

Filed: June 9, 2000

Docket No. A-6585 (191930-1180)

For: **PROGRAM INFORMATION SEARCHING SYSTEM FOR INTERACTIVE PROGRAM
GUIDE**

EVIDENCE UNDER 37 CFR 41.37

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks and evidence for consideration and entry before
submission of an appeal brief.

REMARKS

Claims 2, 3, 5-30, 32-37 and 39-64 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* ("*Rothmuller*," U.S. Pat. No. 5,635,989) in view of *Legall et al.* ("*Legall*," U.S. Pat. No. 6,005,565). Claims 9-14 and 39-41 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* in view of *Legall*, and further in view of *Boyer et al.* ("*Boyer*," U.S. Pat. No. 6,268,849). Claims 2, 3, 5-30, 32-37, and 39-64 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The final Office Action alleged the following with regard to the 112(1) rejection (page 2, section 1):

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 63 and 64, it is unclear as to where support is found for the claimed "...browse-by icon..." recited in claims 63 and 64. There is no disclosure for the claimed "browse-by icon." Furthermore the specification and figures as originally presented do not illustrates[sic] the claimed "browse-by icon."

In the response to final dated November 13, 2007, Applicants provided an Exhibit A, corresponding to a marked-up version of Figure 4 of the original disclosure, with the "icon" encircled and labeled to assist the Examiner, and explained on page 14 of the response to final that exact terminology between specification and claims is not required, that the MPEP 2163 recognizes implicit and inherent disclosure of the claim limitation, and that even assuming *arguendo* there is no explicit disclosure shown and described in association with Exhibit A, the disclosure of the limitation "browse-by-icon" is at least implicit. Further, the response to final dated November 13, 2007 made the following note (page 14):

Additionally, based on Figure 4 and the well-established use of the term "icon" in display and graphics user interface technology, one having ordinary skill in the art would reasonably conclude possession of the claimed subject matter. In that the rejection is believed to have been overcome, Applicants respectfully request that the rejection of these claims under 35 U.S.C. §

112, first paragraph, where not rendered moot by cancellation of claims, be withdrawn.

The Advisory Action dated January 4, 2008 expressed that the Exhibit was considered, but disagreed with Applicants arguments, asserting that the “Exhibit A does not illustrate the claimed limitation ‘BROWSE BY ICON’” and further asserting that there is “no disclosure for the claimed limitation ‘browse-by-icon’. Hence the 103(a) rejection is proper.”

The Panel Decision dated June 17 and based on the Pre-Appeal Brief Request for Review filed by Applicants on January 23, 2008 noted that there remains at least one issue for appeal.

Prior to filing an appeal brief, Applicants respectfully request consideration and entry of the attached Exhibit 1 under 37 CFR 41.37 and MPEP 1206. Exhibit 1 is a page containing an exemplary definition of the word “icon” from “Random House Webster’s Unabridged Dictionary, Second Edition,” dated August 1998. Such an exemplary definition provides in relevant part as follows:

1. a picture, image, or other representation...4. *Computers*. A picture or symbol that appears on a monitor and is used to represent a command, as a file drawer to represent filing.

Applicants respectfully submit that, consistent with the exemplary definition as attached, the symbol “A” in Applicants’ Figure 4 (Exhibit A from the final Office Action response) appears on the screen of a display device and is used in conjunction with the text adjacent the symbol (i.e., “Browse By”) to represent the ability to use the “A” button or key on a remote control device to command browse-by functionality in the IPG in the manner described in Applicants’ specification and as claimed (e.g., page 10, lines 8-16 and page 12, lines 16-22).

Applicants respectfully submit that entry of Exhibit 1 is in compliance to MPEP 2106, which provides as follows:

Affidavits or other evidence (e.g., declarations or exhibits) submitted after the date of filing a notice of appeal, but prior to the date of filing a brief pursuant to 37 CFR 41.37, may be admitted if the examiner determines that:

(A) the affidavits or other evidence overcomes all rejections under appeal; and

(B) a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

To support entry of Exhibit 1, Applicants respectfully note the following supporting facts:

- (1) as of the filing date of the present response, there has been a filing of a Notice of Appeal but an appeal brief has not been filed; and
- (2) the evidence overcomes all rejections under appeal.

With regard to requirement (1) and the 112(1) rejection, it is evident that the exemplary definition of an icon as attached as Exhibit 1 was present by the filing date of the present application, and hence available to one having ordinary skill in the art. Further, in combination with the well-understood meaning of the term “icon,” it is clear that Applicants were in possession of an embodiment of an invention that includes a browse-by icon.” In addition, it is noted that there is an absence of any articulation in the final or Advisory Action of “why” a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed (as required under MPEP 2163.04), and hence a failure to support or maintain a *prima facie* case.

With regard to the 103 rejection, it is noted that the “browse-by” icon was completely ignored in the final Office Action and Advisory Action, and hence omits a necessary element needed to support of a *prima facie* case of obviousness.

For at least the reasons set forth above, Applicants respectfully submit that the evidence overcomes all rejections under appeal.

With regard to the second requirement under MPEP 2106 set forth above, Applicants respectfully submit that, despite Applicants' assertion in the prior responses of the well-established or universal acceptance of what an icon is and conveys, the evidence is necessary to convince the Examiner that it is unreasonable to take the position that one having ordinary skill in the art would not recognize that the combination of the "A" button in view of the adjacent text as a browse-by icon in view of what was known at the time of filing. Further, Applicants respectfully submit that in view of the well-established or universal recognition of anyone who has ever interacted with a computer (and it is noted that the standard for rejecting the claim under 112(1) is not so onerous, but instead, pertains to one having ordinary skill in the art), it was not believed necessary to have to support such assertions of well-established usage with an Exhibit. Instead, Applicants believed the inclusion of Figure 4 in Exhibit A in the response to final and the accompanying explanation would be sufficient to convince the Examiner that one having ordinary skill in the art would understand that the "A" symbol accompanied by the adjacent text pertains to the claimed browse-by icon." Accordingly, it is respectfully believed that the second requirement of MPEP 2106 has been met.

CONCLUSION

Favorable reconsideration and entry of the evidence and/or allowance, or the re-opening of prosecution on the merits, of the present application and claims 2, 3, 5-30, 32-37, 39-54, and 59-64 are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

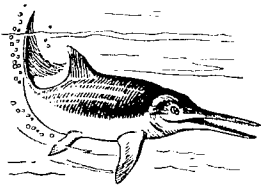
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Ichthyosaurus

of the extinct order Ichthyosauria, ranging from 4 to 10 m (12 to 12 m) in length and having a round, tapering body, a large head, four paddlelike flippers, and a long, thin tail. [1820-30; see *ICHTHYOSAURUS*]
ichthyosau'ri-an, *adj.*, *n.* —*ichthyosau'roid*, *adj.*



ichthyosau'rus (ik'the ə sōr'əs), *n.*, *pl.* —*us-es*.
ichthyosau'rus. [1825-35; < NL; see *ICHTHYO-*, *-SAURUS*]
ichthyos'is (ik'the ə sis), *n.* *Pathol.* a hereditary disease in which the epidermis continuously flakes off in large scales or plates. [1805-15; NL; see *ICHTHYO-*, *-OSIS*]
ichthyot'ic (ik'the ə t'ik), *adj.*

ichthyot'ic, a suffix forming personal nouns denoting occupation: beautician; mortician. [extracted from musician, physician, etc., derived, with *-IAN*, from words ending in *-ic*]

icicle (i'sī kəl), *n.* 1. a pendant, tapering mass of ice formed by the freezing of dripping water. 2. a thin strip of ice, plastic, or foil, usually silvery, for hanging on a Christmas tree as decoration. 3. a cold, unemotional person. [bef. 1000; ME *isikel*, OE *isigcel*, equiv. to *is* ICE + *cel*, akin to ON *jökul* mass of ice, glacier]
icicle, *adj.*

icily (i'sī lē), *adv.* in an icy manner: *I received him icily* because of the harsh way he had treated me. [1840-50; < *ice* + *-ly*] —*iciness*, *n.*

icing (i'sing), *n.* 1. a sweet, creamy spread, as of confectioners' sugar, butter, and flavoring, for covering cakes, cookies, etc., frosting. 2. Meteorol. a coating of ice on a solid object. Cf. *glaze*, *rime*. 3. Aviation. the coating of atmospheric moisture on the surface of an aircraft. 4. Ice Hockey. the act of a player shooting the puck from the defensive half of the rink over the opponent's goal line, but not into the goal, as a defensive maneuver to keep the puck out of the reach of attacking players, resulting in a penalty against the defensive player if the puck is then next touched by an opponent rather than the goalkeeper. 5. *icing on the cake*. See *icing* (def. 5). [1760-70; ICE + *-ing*]

icy, *an*, *adj.* used as an expression of distaste or repugnance.

ick (ik'ər), *n.* Scot. the fruit-bearing spike of any plant, esp. an ear of corn. [1505-15; Scots form of OE *ehher*, *ehher* (Northumbrian dial.)]

ick (ik'ez), *n.* Harold (Le Claire) (la klär), 1874-1952, U.S. lawyer and statesman.

ick (ik'ez), *adj.* *ick-ier*, *ick-i-est*. Informal. 1. repulsive or distasteful. 2. excessively sweet or sentimental. 3. unsophisticated or old-fashioned. 4. sticky; viscous. [1830-35; Amer.; *ick* (of uncert. orig.) + *-y*]

icky, *n.* 1. revolting, nasty. 2. gummy, gooey, gucky. 3. (Kon), *n.* 1. a picture, image, or other representation. 2. Eastern Ch. a representation of some sacred image, as Christ or a saint or angel, painted usually on a wood surface and venerated itself as sacred. 3. a representation that stands for its object by virtue of a resemblance or analogy to it. 4. Computers. a picture symbol that appears on a monitor and is used to represent a command, as a file drawer to represent a file. Also, *ekon*, *ikon* (for def. 1, 2). [1565-75; < L < Gk *eikōn*, *eikōn* (image, figure)]

ikon, *n.* 1. See *image*.

iconic (ik'ən'ik), *adj.* 1. of, pertaining to, or characteristic of an icon. 2. Art. (of statues, portraits, etc.) external according to a convention or tradition. Also, *iconical*. [1650-60; < L *iconicus* < Gk *eikonikos*, equiv. to *eikōn* (s. of *eikōn*) *ikon* + *-ikos* -ic] —*iconic/i-*, *adj.*

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< ML *iconographia* < Gk *eikonographia*. See *ICONO-*, *-GRAPHY*] —*icon-o-graph* (i kōn'ə gräf', -gräf'), *n.* —*iconog'ra-pher*, *n.*

iconol'a-try (i'kō nōl'ə trē), *n.* the worship or adoration of icons. [1615-25; *ICONO-* + *-LATRY*] —*iconol'a-ter*, *n.* —*iconol'a-trous*, *adj.*

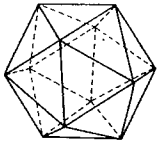
iconol'o-gy (i'kō nōl'ə jē), *n.* 1. the historical analysis and interpretive study of symbols or images and their contextual significance; iconography. 2. the study of icons or symbolic representations. [1720-30; *ICONO-* + *-LOGY*] —*icon-o-log-i-cal* (i kōn'ə lōj'ī kəl, i'kō nōl-), *adj.* —*iconol'o-gist*, *n.*

iconophile (i kōn'ə fīl'), *n.* a connoisseur of icons or images. [1880-85; *ICONO-* + *-PHILE*] —*iconophili-sm* (i'kō nōl'ə liz'əm), *n.*

icono-scope (i kōn'ə skōp'), *n.* a television camera tube in which a beam of high-velocity electrons scans a photoemissive mosaic. Cf. *orthicon*. [1930-35; formerly trademark; see *ICONO-*, *-SCOPE*]

icono-s'ta-sis (i'kō nōs'tə sis), *n.*, *pl.* —*-ses* (-sez'). Eastern Ch. a partition or screen on which icons are placed, separating the sanctuary from the main part of the church. Also, *icon-o-stas* (i kōn'ə stas'). [1825-35; < MGk; see *ICONO-*, *-STASIS*]

icosahedron
(regular)



ico-sa-he-dron (i kōsə hē'drən, i kōs'ə-), *n.*, *pl.* —*-drons*, *-dra* (-dra). a solid figure having 20 faces. [1560-70; < Gk *eikosaedron*, equiv. to *eikosa-* (var. of *eikosi-*, comb. form of *eikosi* twenty) + *-edron* -hedron] —*ico-sa-he-dral*, *adj.*

ico-si-tet-ra-he-dron (i kōs'i tē'trə hē'drən, i kōs'ə-), *n.*, *pl.* —*-drons*, *-dra* (-dra). a solid figure having 24 faces. [1825-35; < Gk *eikosi-* (comb. form of *eikosi* twenty) + *TETRAHEDRON*]

-ics, a suffix of nouns that denote a body of facts, knowledge, principles, etc., usually corresponding to adjectives ending in *-ic* or *-ical*: *ethics*; *physics*; *politics*; *tactics*. [pl. of *-ic*, repr. L *-ica* (< Gk *-ika*, neut. pl. of *-ikos*), as in *rhetorica* (pl.) rhetoric book]

Usage. Nouns ending in *-ics* that name fields of study, sciences, arts, professions, or the like are usually not preceded by an article and are used with a singular verb: *Acoustics* (the science) *deals with sound*. *Politics* (the art of government) *fascinates me*. In certain uses, often when preceded by a determiner like *the*, *his*, *her*, or *their*, most of these nouns can take a plural verb: *The acoustics* (the sound-reflecting qualities) *of the hall are splendid*. *Their politics* (political opinions) *have antagonized everyone*.

ICSH, 1. interstitial-cell stimulating hormone: a hormone produced by the anterior lobe of the pituitary gland that, in the male, stimulates the interstitial cells of the testes to produce testosterone; chemically identical to luteinizing hormone of the female. 2. *Pharm.* a commercial form of this substance, obtained from the pituitary glands of pigs and sheep.

icteric (ik tēr'ik), *adj.* *Pathol.* pertaining to or affected with icterus; jaundiced. Also, *icteric/i-cal*. [1590-1600; < L *ictericus* < Gk *ikterikos*, equiv. to *ikter* (ros) jaundice + *-ikos* -ic]

icterus (ik tēr'əs), *n.* *Pathol.* jaundice (def. 1). [1700-10; < L < Gk *ikteros* jaundice, a yellow bird said to cure jaundice when seen]

ictinus (ik tī'nos), *n.* fl. mid-5th century B.C., Greek architect, a designer of the Parthenon.

ictus (ik'təs), *n.*, *pl.* —*-tus*, *-tus*. 1. Pros. rhythmical or metrical stress. 2. *Pathol.* a. an epileptic seizure. b. a stroke, esp. a cerebrovascular accident. [1700-10; < L stroke, thrust, equiv. to *icere* to strike with a weapon + *-tus* suffix of v. action] —*ictic*, *adj.*

ICU, See *intensive care unit*.

icy (i'sē), *adj.* *ic-ier*, *ic-i-est*. 1. made of, full of, or covered with ice: *icy roads*. 2. resembling ice. 3. cold: *icy winds*. 4. without warmth of feeling; coldly unfriendly; frigid: *an icy stare*. [bef. 900; ME *isy*, OE *isig*. See *ice*, *-y*]

Syn. 4. cold, distant, cool, chilly.

id (id), *n.* *Psychoanal.* the part of the psyche, residing in the unconscious, that is the source of instinctive impulses that seek satisfaction in accordance with the pleasure principle and are modified by the ego and the superego before they are given overt expression. [1920-25; < L *id* *id*, as a trans. of G Es, special use of *es* it, as a psychoanalytic term]

ID (i'dē), a means of identification, as a card or bracelet containing official or approved identification information.

ID, 1. Idaho (approved esp. for use with zip code). 2. Also, *id*, inside diameter.

I'd (id), contraction of *I would* or *I had*.

Usage. See *contraction*.

-id', a suffix of nouns that have the general sense "offspring of, descendant of," occurring originally in loanwords from Greek (*Atreid*; *Nereid*), and productive in English on the Greek model, esp. in names of dynasties, with the dynasty's founder as the base noun (*Abbasid*; *Attalid*), and in names of periodic meteor showers, with the base noun usually denoting the constellation or other celestial object in which the shower appears (*Perseid*). [< L *-id-*, s. of *-is* < Gk fem. patronymic suffix; or < L *-ides* < Gk masc. patronymic suffix]

-id', a suffix occurring in English derivatives of modern Latin taxonomic names, esp. zoological families and

classes; such derivatives are usually nouns denoting a single member of the taxon or adjectives with the sense "pertaining to" the taxon: *arachnid*; *canid*. [< Gk *-ides* -id', as sing. of NL *-ida* -ida or *-idae* -idae]

-id', var. of *-ide*: *lipid*.

-id', a suffix occurring in descriptive adjectives borrowed from Latin, often corresponding to nouns ending in *-or*: *fetid*; *humid*; *pallid*. [< L *-idus*]

ID, (in Iraq) *dinar*; *dinars*.

Id., Idaho.

id., idem.

ID., 1. identification. 2. identity. 3. *Mil.* Infantry Division. 4. Intelligence Department. [1950-55]

I-da (i'də), *n.* 1. **Mount**, a mountain in W Turkey, in NW Asia Minor, SE of ancient Troy. 5810 ft. (1771 m). Turkish, *Kazdag*. 2. **Modern**, **Mount Psiloriti**, the highest mountain in Crete. 8058 ft. (2456 m). 3. a female given name: from a Germanic word meaning "happy."

IDA, International Development Association.

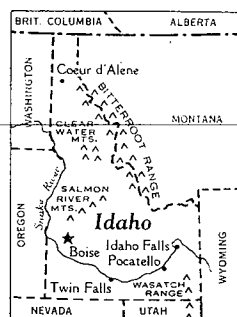
-ida, *Zool.* a suffix of the names of orders and classes: *Arachnida*. [< NL, taken as neut. pl. of L *-ides* offspring of < Gk; see *-id'*]

Ida., Idaho.

-idae, *Zool.* a suffix of the names of families: *Canidae*. [< NL, L < Gk *-idae*, pl. of *-ides* offspring of; akin to *-id'*]

I-dae-an (i dē'an), *adj.* of, pertaining to, associated with, or inhabiting Mount Ida in Asia Minor or Crete. [1580-90; < L *Idaeus* (< Gk *Idaios* Idaean) + *-an*]

I-da-ho (i'də hō'), *n.* a state in the NW United States. 943,935; 83,557 sq. mi. (216,415 sq. km). *Cap.*: Boise. *Abbr.*: ID (for use with zip code). *Id.*, *Ida.* —**I-da-ho-an** (i'də hō'an, i'də hō'-), *adj.*, *n.*



I'daho Falls', a city in E Idaho. 39,590.

'Id al-Ad-ha (id' al əd hā'), a major festival of Islam, beginning on the tenth day of the last month of the calendar and lasting for four days, usually characterized by the sacrificing of a sheep, whose flesh is divided among relatives and friends in memory of the ransom of Ishmael with a ram. Also called **Great Festival**.

IDB, industrial development bond.

ID bracelet. See *identification bracelet*.

ID card. See *identification card*. [1960-65]

id-dhi (id'dē), *n.* *Pali*. *siddhi*.

-ide, a suffix used in the names of chemical compounds: *bromide*. Also, *-id*. [extracted from *oxide*]

ide-a (i dē'ə, i dē'), *n.* 1. any conception existing in the mind as a result of mental understanding, awareness, or activity. 2. a thought, conception, or notion: *That is an excellent idea*. 3. an impression: *He gave me a general idea of how he plans to run the department*. 4. an opinion, view, or belief: *His ideas on raising children are certainly strange*. 5. a plan of action; an intention: *the idea of becoming an engineer*. 6. a groundless supposition; fantasy. 7. *Philos.* a concept developed by the mind. b. a conception of what is desirable or ought to be; ideal. c. (cap.) *Platonism*. Also called **form**, an archetype or pattern of which the individual objects in any natural class are imperfect copies and from which they derive their being. d. *Kantianism*. See *idea of pure reason*. 8. *Music*. a theme, phrase, or figure. 9. *Obs.* a. a likeness. b. a mental image. [1400-50; < LL < Gk *idéa* form, pattern, equiv. to *ide-* (s. of *idein* to see) + *-a* fem. n. ending; r. late ME *idee* < MF < LL, as above; akin to *wit*!] —**ide-a-less**, *adj.*

Syn. 1, 2. **IDEA**, **THOUGHT**, **CONCEPTION**, **NOTION** refer to a product of mental activity. **IDEA**, although it may refer to thoughts of any degree of seriousness or triviality, is commonly used for mental concepts considered more important or elaborate: *We pondered the idea of the fourth dimension*. *The idea of his arrival frightened me*. **THOUGHT**, which reflects its primary emphasis on the mental process, may denote any concept except the more weighty and elaborate ones: *I welcomed his thoughts on the subject*. *A thought came to him*. **CONCEPTION** suggests a thought that seems complete, individual, recent, or somewhat intricate: *The architect's conception delighted them*. **NOTION** suggests a fleeting, vague, or imperfect thought: *a bare notion of how to proceed*. 4. sentiment, judgment.

ide-a-is-tic (i dē'ə is'tik, i dē'ə-, i dē'is'-), *adj.* of ideas, esp. in their abstract or symbolic character. [**IDEA** + *-istic*]

CONCISE PRONUNCIATION KEY: act, cāpe, dāre, pārt; set, ēqual; if, ice; ox, ōver, ōrder, oil, bōok, bōdy, out; up, ūrge; child; sing; shoe; thin; that; zh as in treasure. a = a as in alone, e as in system, i as in easily, o as in gallop, u as in circus; * as in fire (fī'r), hour (hō'r). l and n can serve as syllabic consonants, as in *cradle* (krād'l) and *button* (but'n). See the full key inside the front cover.